

REMARKS

Claims 13, 19, 29, 31-35, 37-38, 40-42, 44 and 45 are pending. Claims 15-18, 21, 22, 30, 36, 39 and 43 have been canceled. Claims 29, 31, 33, 34, 40 and 41 have been amended.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 29, 31, 33, 34, 40 and 41 have been amended, and claims 15-18, 21, 22, 30, 36, 39 and 43 have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 29, 31, 33, 34, 40 and 41 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to “the invention” is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Interview Summary

Examiner Darrow is thanked for the in person interview of February 22, 2005. The Practitioner, the Applicant and the Examiner discussed the appropriate documentation required to swear behind the Brundrett reference. The Examiner confirmed that reduction to practice must be established for the dependent claims in addition to the independent claims in the pending application.

Specification

The Examiner objected to paragraph [0002] because referenced Application No. 09/259,991 filed March 1, 1999 has now issued as U.S. Patent No. 6,981,141. Paragraph [0002] has been amended to state this per the Examiner's request, overcoming the objection.

Claim Objections

The Examiner objected to claims 33 and 40. This objection is respectfully traversed. The Examiner recommended that the term "record" in line 5 of each of claim 33 and 40 should be replaced with "recorded." The Practitioner respectfully apprises the Examiner that both claim 33 and 40 are process claims wherein the step "record" is used in the present tense to perform a process step (i.e. "to record. . .").

Claim Rejections - 35 USC § 112

The Examiner rejected claim 13 under 35 USC § 112, second paragraph as indefinite. This rejection is respectfully traversed. The Examiner asserted that the limitation "electronic document management system" in line 4 lacks antecedent basis.

The Practitioner apprises the Examiner of the Preliminary Amendment filed May 13, 2005, on page 2:

Claim 13 (Currently amended): The process of decrypting documents of claim 29 A method of encrypting a document as set forth in claim 12 wherein the further comprising providing an electronic document management system comprising comprises a SQL database, a SQL database server and a SQL database client, wherein the electronic document management system performs the detecting step, the SQL database client being disposed in the general purpose computer.

As previously presented in line 2 of claim 13, antecedent basis is provided via the term “an” immediately preceding “electronic document management system.”

Therefore, it is respectfully requested that the rejection be withdrawn.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 19, 29, 31-35, 37-38, 40-42, 44 and 45 under 35 USC § 102(e) as anticipated by Brundrett et al. (USP 6,249,866). This rejection is respectfully traversed.

A similar rejection was made in Re-Examination 90/006,529, the grandparent application. Examiner Darrow withdrew the rejection in view of declarations filed under Rules 1.131 and 1.132. The claims at issue here claim priority from the grandparent application. Thus, a similar set of declarations are presented here.

Pursuant to Rule 1.131(a), enclosed is a declaration by Stephen Zizzi establishing reduction to practice of the subject matter rejected in claims 19, 29, 31-35, 37-38, 40-42, 44 and 45 prior to the effective date of the Brundrett reference, 09/16/1997.

Pursuant to Rule 1.132, enclosed are declarations by Christopher Mahne and Paul Halpern corroborating Stephen Zizzi's declaration.

The declarations presented here include similar content and format which were found to be persuasive in the Re-Examination of the grandparent application. Moreover, both the exhibits and the numbering of the exhibits associated with the declarations by Stephen Zizzi, Christopher Mahne and Paul Halpern are identical to those submitted in Re-Examination Number 90/006,529. The purpose of using identical numbering is to avoid confusion. The Exhibits included in the declarations by Stephen Zizzi, Christopher Mahne and Paul Halpern are those which were found to be persuasive in Re-Examination Number 90/006,529.

Based on the information provided with the enclosed declarations and their respective exhibits, Brundrett is not a reference that can be applied to render anticipated claims 19, 29, 31-35, 37-38, 40-42, 44 and 45.

Therefore, it is respectfully requested that the rejection be withdrawn.

Claim Rejections - 35 USC § 103

The Examiner rejected claim 13 under 35 USC § 103 as obvious from Brundrett in view of Chan (USP 5,713,018). This rejection is respectfully traversed.

Based on the information provided with the enclosed declarations and their respective exhibits, Brundrett is not a reference that can be applied to render obvious claim 13. Therefore, claim 13 is not obvious from Brundrett in view of Chan.

It is respectfully requested that the rejection be withdrawn.

Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: April 11, 2006



Joel G. Landau, Reg. No. 54,732

Appl. No. 10/658,246
Amdt. Dated 4/11/2006
Response to Office action dated 01/18/2006

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com